

REMARKS

By this Amendment, claims 1, 2, 14, 15, 17, 32, 44, 45, 57, 70 and 71 are amended. No new claims are added and no claims are added. Currently claims 1-76 are pending. Applicants respectfully request the Examiner to reconsider the outstanding rejections in view of the above amendments and following remarks.

I. Claim Rejections Under 35 U.S.C. § 101

The Examiner has rejected claims 14, 31 and 44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner alleges that independent 14, 31 and 44 lack certain statutorily required functionality. Applicants respectfully disagree.

Applicants respectfully point out that MPEP § 2107 sets forth guidelines for the examination of patent applications under the "Utility Requirement". Under MPEP 2107, an invention is "useful" when the utility is specific, substantial and credible. A utility is specific, if it is particular to the subject matter claimed. A substantial utility is found if one skilled in the art can use the claimed invention in a manner which provides some immediate benefit to the public. A credible utility is found if a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. See, for example, MPEP 2107.

Applicants respectfully submit that the claimed invention satisfies the three-pronged test of "utility requirement" mentioned above. The claimed invention is directed to a specific subject matter which includes a method of providing a user interface. Such method clearly provides a substantial utility since it provides a "real world" use by providing a practical application such as a user interface for a desktop display. This utility is also credible since a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. Accordingly, it is respectfully submitted that the claimed invention satisfies the three-pronged test of utility requirement and, thus, the claimed invention is useful and provides a practical application.

Although Applicants respectfully disagree with the Examiner's contention that independent claims 14, 31 and 44 are directed to non-statutory subject matter, these claims have been amended to recite, *inter alia*, "a user interface" (claim 14), and "a desktop manager" (claims 31 and 44) merely to expedite prosecution. Accordingly, Applicants respectfully request withdrawal of this rejection based on section 101.

II. Claim Rejections Under 35 U.S.C. § 102 and § 103

The Examiner has rejected claims 1, 2, 5-9, 12-14, 32-34, 43, 44, 57-59, 66, 67, 69-72, 75 and 76 under 35 U.S.C. § 102(b) as being anticipated by IBM Technical Disclosure Bulletin "Workspace Tiling Control," dated November 1, 1995, (hereinafter, "IBM TBD"); and rejects claims 15 - 26, 29 - 31, 45 - 54, and 56 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,694,150 to Sigona et al. (hereinafter "Sigona"); and rejects claims 3, 4, 35 - 41, 60 - 64, and 68 under 35 U.S.C. § 103(a) as being unpatentable over IBM TBD in view of Sigona; and rejects claims 10, 11, 42, 65, 73, and 74 under 35 U.S.C. § 103(a) as being unpatentable over IBM TBD in view of U.S. Patent No. 6,249,290 to Herndon et al. (hereinafter "Herndon"); and rejects claims 27, 28, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Sigona in view of Herndon. Applicants respectfully traverse these rejections.

With regards to IBM TBD, the Applicants submit that, in dramatic contrast to the claimed invention, none of the asserted references, whether have taken alone or in combination at least teach, disclose or suggest each and every element of the claimed invention, for example, independent claim 1 identified above. That is, as best understand, there is simply nothing in IBM TBD, Sigona, or Herndon, that merely suggests found within the method or system for providing a user interface, *inter alia* accepting user input including at least a partial copy of the first viewable region; and providing a jump pane in the first viewable region, where the user input to the first viewable region is associated to both data and control for the second viewable region, as required by claim 1, for example.

For at least these reasons, Applicants submit that IBM TBD fails to at least teach or suggest each and every claim combination of elements recited by, for example

amended claim 1. As such, amended claim 1 is clearly patentable. Because independent claims 32, 57 and 70 are similarly amended as is claim 1, independent claims 32, 57 and 70 are similarly patentable over the asserted references, and specifically as to IBM TBD. Because claims 2-14, 33-44, 58-69 and 71-76 depend from claims 1, 32, 57 and 70 respectively, claims 2-14, 33-44, 58-69 and 71-76 are at least patentable by virtue of their dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 1, 2, 5-9, 12-14, 32-34, 43, 44, 57-59, 66, 67, 69-72, 75 and 76 as applied to IBM TBD under section 102 is respectfully requested.

For at least the reasons set forth above, Applicants also submit that the Sigona reference fails to at least teach or suggest the claimed combination of elements recited by at least amended independent claims 15 and 45. Specifically, Applicants respectfully assert that the method including accepting user input including at least a partial copy of the first viewable region; and providing a jump pane in the first viewable region, where the user input to the first viewable region is associated with both data and control for the second viewable region, as recited by claim 15, is clearly patentable over Sigona, and so similarly is independent claim 45. Because claims 16-31 and 46-51 depend from independent claims 15 and 45, respectively, claims 16-31 and claims 46-56 are at least patentable by virtue of the dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 15-26, 29-31, 45-54 and 56 as applied to Sigona under section 102 is respectfully requested.

For at least the reasons discussed above, Applicants respectfully submit that even when IBM TBD and Sigona are applied in combination, they fail to make up for what is lacking in their individual application, specifically Applicants respectfully assert that the claimed subject matter is clearly patentable over the combination of IBM TBD in view of Sigona under section 103.

For at least these reasons, and as set forth above individually, the combination of IBM TBD and Sigona fail to render obvious the claimed subject matter of claims 3, 4, 35-41, 60-64 and 68. As set forth above, and as argued individually, and even when taken in combination, and as applied to section 103, claims 3, 4, 35-41, 60-64 and 68 are clearly

patentable. Accordingly, the immediate withdrawal of the prior art rejections of claims 3, 4, 35-41, 60-64 and 68 to the combination of IBM TBD and Sigona, under section 103, is respectfully requested.

With regards to Herndon, Applicants respectfully assert that Herndon fails to provide what is lacking when taken in combination with IBM TBD. Specifically, Herndon merely teaches an object-oriented zooming engine for a graphical user interface. See, for example, Herndon Abstract. As such, Applicants respectfully assert that Herndon would offer nothing to motivate a person to modify IBM TBD to arrive at Applicants' claimed invention. Therefore, for at least these reasons, as well as those discussed above with regards to IBM TBD, claims 10, 11, 42, 65, 73 and 74 are clearly patentable over IBM TBD in view of Herndon. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 10, 11, 42, 65, 73 and 74 as applied to Herndon under section 103.

For at least the reasons discussed above, and as applied to Sigona individually, Herndon fails to provide what is missing with regards to Sigona to render obvious Applicants' claimed invention, specifically to claims 27, 28 and 55 which are rejected under section 103. Accordingly, for at least the same reasons discussed above, Applicants respectfully request the withdrawal of the rejection of claims 27, 28 and 55 over the combination of Sigona in view of Herndon under section 103.

III. Conclusion

All matters having been addressed in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Should there be any outstanding matters that need to be resolved in the present application, The Examiner is respectfully requested to contact Michael R. Cammarata, Reg. No. 39,491 at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: July 5, 2007

Respectfully submitted,

By 

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